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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,451

07/06/2005

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23373 7590 09/11/2008
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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

09/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,451	Applicant(s) MASUTANI ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4, 7 to 0, 11 to 14 and 27 to 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4, 7 to 0, 11 to 14 and 27 to 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/13/08, 2/24/06, 7/6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election without traverse of the fluorine containing resin having hydroxyl (A), a liquid polydialkylsiloxane having amino group (B) and an isocyanate or amino compound (C) in the reply filed on 6/26/08 is acknowledged.

Applicants include a list of claims that read thereon, but the Examiner disagrees with this list. For instance they include claim 5, but this claim is drawn to the fluoropolyether (B2) species that was not elected. They also include claim 10, which is drawn to a combination of an isocyanate and silicate curing agent. The following is a list of claims that the Examiner believes to be readable thereon: claims 1-4, 79, 11-14 and 27-31.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 to 4, 7 to 10, 11 to 14 and 27 to 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanada et al. '042.

Hanada et al. teach a composition in which a fluoropolymer film forming component is mixed with a silane coupling agent having at least one free isocyanate group and the reaction product of a polysiloxane and an organo polyisocyanate. See for instance the top of column 2, lines 5 to 11.

The silane coupling agent on the bottom of column 2, lines 55 to 60, meets the claimed (and elected) curing agent, as well as the requirement of claim 14. In addition, the organic polyisocyanate on column 7, lines 25 and on, also meets the claimed (and elected) curing agent. The reaction product of the silane coupling agent and the polysiloxane taught starting on the bottom of column 2 and through column 3 meets the claimed liquid polydialkylsiloxane having a functional group Y¹. Particularly note that the amino modified polysiloxanes taught as (1) on the top of column 3 meets the elected species of (B1). The bottom of column 9 teaches fluoropolymer as a film forming resin

that contains isocyanate reactive functional groups such as hydroxyl. This meets the synthetic resin (A) as claimed, as well as the specific elected species.

Thus Hanada et al. teach a composition that contains each of the three claimed components. For the specific elected compound (B), while Hanada et al. preferably react the aminopolysiloxane with an isocyanate prior to admixture with the film forming resin, this is not excluded from the claimed composition, which merely requires the three components as claimed.

For instance, the Examiner draws attention to Referential Example 3 in which a fluoro-resin meeting the requirements of claims 11 and 12 are admixed with isocyanate silane meeting claim 14. This includes a polysiloxane meeting the generic requirement of (B1) in claim 1 as well as a polyisocyanate meeting (C) in claim 1. For the specifically elected polydialkylsiloxane having amino groups, the Examiner again notes that column 3 specifically teaches, and thus anticipates, such siloxanes in the composition of Hanada et al. For claim 30, note the various solvents disclosed on column 9, lines 45 and on. Column 10, lines 45 and on, teaches a catalyst meeting claim 27.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanada et al.

While Hanada et al. do not teach an aqueous dispersion medium, one having ordinary skill in the art would have found such a composition obvious over that which is known in the art. Specifically the Examiner notes that the alternative use of aqueous and solvents based coating systems is well known in the art, with aqueous systems offering the benefit of having reduced VOC. Thus one having ordinary skill in the art would have found the formation of an aqueous system over the solvent based system of

Art Unit: 1796

Hanada et al. to have been an obvious means of reducing the VOC of the composition therein while keeping the composition in a flowable system that can readily be applied as a coating. In this manner claim 31 is rendered obvious.

6. Hanada et al., Murase and Narisawa et al. are cited as being of general interest. These references teach various composition that meet and/or render obvious at least some of the claims but are not as close to the elected species as the prior art reference cited supra.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
9/7/08